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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GRAY, JILL M

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 12/19/2001

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/559,595

Applicant(s)

PRIGENT ET AL

Examiner

Jill M Gray

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12-16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1774

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it contains legal phraseology.

Correction is required. See MPEP § 608.01(b).

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In Fig. 2, "20".

Art Unit: 1774

Correction is required.

Claim Objections

5. Claims 12-16 are objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 12-16 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for organic compounds as set forth on pages 3 and 4 of the specification and inorganic compounds as set forth on pages 2 and 3 of the specification, does not reasonably provide enablement for the broad terminology of “organic compound” and “inorganic compound”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. In particular, the language of “organic compound” and “inorganic compound” is broad and encompasses compounds not disclosed in the specification such as cellulose and cement. Accordingly, the specification is not commensurate in scope with the claims.

Art Unit: 1774

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 3-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-11 lack the proper Markush language. The suggested language is "selected from the group consisting of..."

Also, claim 7 is indefinite because it is not clear as to how this claim further defines the clay of claim 5.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

11. Claims 1-3, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by

European Patent Publication No. 0145213 (Bury).

Art Unit: 1774

Bury teaches a cable comprising at least one optical fiber and at least one covering layer comprising a polymer covering material and an inorganic compound which is an inorganic oxide, as required by claims 1-3, 8 and 11. It should be noted that applicants' claims are not specific as to the structural relationship between the covering layer and optical fiber. Therefore, the teachings of Bury anticipate the invention as claimed in present claims 1-3, 8 and 11.

12. Claims 1-5, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Rinehart et al., 5,324,588 (Rinehart).

Rinehart teaches a covering layer comprising organic vinyl polymer compounds, as required by claims 8 and 10 and inorganic compounds such as clay, talc, as required by claims 2-5, said covering layer being used to protect optical fibers in a cable. See column 4, lines 10-24, column 9, lines 4-6. Therefore, the teachings of Rinehart anticipate the invention as claimed in claims 1-5, 8 and 10.

13. Claims 1-5 and 8-11 are rejected under 35 U.S.C. 102(b) and (e) as being anticipated by Kinaga et al, 5,182,786 - 102(b) (Kinaga) or Szum et al, 6,110,593 - 102(e) (Szum).

Kinaga and Szum each teach cables comprising at least one optical fiber and covering layer comprising an organic compound and an inorganic compound. Each teach organic compounds such as acrylates and silicone polymers as set forth by applicants in claims 8-11 and inorganic compounds such as clay, talc and mica, as required by claims 2-5. See Kinaga, column 2, lines 25-30, column 3, lines 38-45; Szum, column 3, lines 20-25, column 4, line 30,

Art Unit: 1774

column 5, line 33-34, and column 28, lines 8-9. Accordingly, the prior art teachings of Kinaga and Szum anticipate the invention as claimed in claims 1-5 and 8-11.

14. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Brauer, 5,672,640.

Bauer teaches a cable having at least one optical fiber, and a covering layer comprising a covering material and an inorganic compound. The covering material is of the type contemplated by applicants in claims 8-11, such as elastomers and acrylates and the inorganic compound can be an oxide as set forth by applicants in claims 2-7, such as clays such as bentonite. As set forth previously, applicants claims are not specific as to the structural relationship between the optical fiber and covering layer. Accordingly, the prior art teachings of Bauer anticipate the invention as claimed in the present claims.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szum or Kinaga, each as applied above to claims 1-5 and 8-11, each in view of Brauer, as applied above to claims 1-11.

Art Unit: 1774

Szum and Kinaga are each as applied above but are silent as to the specific clays which can be used. Brauer teaches that it is known in the art to produce covering layers for optical fiber cables wherein said covering layers comprising clays as a inorganic compound, said clays being of the same type set forth by applicants in claims 6 and 7.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to use as the clays taught by Szum and Kinaga, a clay such as bentonite, as taught by Brauer, with the reasonable expectation of success of a known compound functioning in its known manner. The specific type of clay is not construed to be a matter of invention in the absence of clear factual evidence to the contrary of superior or unexpected properties, said properties being directly to the specific clay material.

No claims are allowed.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. M. Gray whose telephone number is (703) 308-2381.

jmg

December 17, 2001

J. M. Gray
Group 1700